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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/141,318	08/27/1998	HIROSHI ISOMURA	1046.1190/J	9722

7590 01/03/2002  
STAAS & HALSEY  
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WASHINGTON, DC 20001

EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 01/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/141,318

Applicant(s)

Isomura

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-9, 12-17, 20-24, 27-31, and 34-38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 12-17, 20-24, 27-31, and 34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(e) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendment filed 10/9/2001 (paper no. 10).

### ***Claim Rejections - 35 U.S.C. § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US PAT. 6,092,102) in view of Wang (US PAT. 5,757,891).

Regarding claim 1, Wagner teaches an apparatus (8) with an information managing function for connecting with at least a information server (16) and a plurality of terminal devices (10, 12, 14) as shown in figure 1 (col. 6 lines 10-14), said apparatus comprising access means (22) for accessing to the information server (col. 6 lines 24-26), a memory (24) for storing an information download from the information server through the access means (col. 6 lines 26-29), event monitor (4) read as a mail status memory for storing each status of the information stored in the memory so as to correspond to each of the terminal devices, wherein the event monitor having a transaction log to

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indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and transmission means (30) for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes.

Regarding claim 3, Wagner teaches the transaction log for storing a process to be applied to the information downloaded to each of the terminal devices (col. 9 lines 40-53).

Regarding claim 5, Wang teaches the telephone further comprising emergency process means for determining whether a priority is necessary (col. 9 lines 7-20).

Regarding claim 6, Wang teaches an identifier memory for storing an identifier of a device to be connected so that it is permitted to access from the device of which the identifier coincides with the stored identifier (col. 7 line 64 through col. 8 line 12).

Regarding claim 7, Wagner teaches an information managing method in an apparatus (8) for transmitting and receiving information to and from at least an information server (16) and a plurality

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of terminal devices (10, 12, 14), said method comprising the steps of a reading process of reading the information in the information server (col. 6 lines 24-26), a storing process of storing the information read in the reading process (col. 6 lines 26-29), a notify process for notifying a status of the information stored in the storing process to indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and a transmission process for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes.

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 7.

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4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US PAT. 6,092,102) in view of Wang (US PAT. 5,757,891) as applied in claim 3 above, and further in view of Murakami et al. (US PAT. 5,590,178 hereinafter Murakami).

Regarding claim 4, the combination of Wagner and Wang differs from the claimed invention in not specifically teaching the process to be applied to the information including deleting the information and keeping the information. However, Murakami teaches an electronic mail system providing a key for deleting respective electronic mail messages (col. 10 lines 31-35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Wagner and Wang in having an user interface applied to the information including deleting and keeping, as per teaching of Murakami, because it makes user friendly so that the information is capable of deleting and keeping upon user's selection.

5. Claims 9, 12-17, 20-24, 27-31 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US PAT. 6,092,102) in view of Wang (US PAT. 5,757,891) and Fuller et al. (US PAT. 5,224,156 hereinafter Fuller).

Regarding claim 9, Wagner teaches an apparatus (8) with an information managing function for connecting with at least a information server (16) and a plurality of terminal devices (10, 12, 14) as shown in figure 1 (col. 6 lines 10-14), said apparatus comprising access means (22) for accessing to the information server (col. 6 lines 24-26), a memory (24) for storing an information download from the information server through the access means (col. 6 lines 26-29), event monitor (4) read

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as a mail status memory for storing each status of the information stored in the memory so as to correspond to each of the terminal devices, wherein the event monitor having a transaction log to indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and transmission means (30) for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes. Furthermore, neither Wagner nor Wang specifically teaches transmitting the information in response to an access made by the terminal device. However, Fuller teaches a method to retrieve messages in response to access made by recipient's terminal (col. 2 lines 35-68). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Wagner and Wang to transmit the information in response to an access made by the terminal device, as per teaching of Fuller, because it causes a message to be received at a reception side in a confidential manner.

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Regarding claim 12, Wang teaches specifying means for specifying how the information transmitted to the plurality of terminal devices (col. 6 lines 45-47).

Regarding claim 13, Wang discloses the e-mail apparatus comprising means for receiving electronic mail from each terminal device and for transmitting the received electronic mail to the service (figure 2).

Regarding claim 14, Wang teaches the telephone further comprising emergency process means for determining whether a priority is necessary (col. 9 lines 7-20).

Regarding claim 15, Wang teaches an identifier memory for storing an identifier of a device to be connected so that it is permitted to access from the device of which the identifier coincides with the stored identifier (col. 7 line 64 through col. 8 line 12).

Regarding claim 16, Wang teaches that the e-mail apparatus is provided in a telephone for (figure 2 and col. 6 lines 10-32).

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 9.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 12.

Regarding claim 21, the limitations of the claim are rejected as the same reasons set forth in claim 13.

Regarding claim 22, the limitations of the claim are rejected as the same reasons set forth in claim 14.



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Regarding claim 23, the limitations of the claim are rejected as the same reasons set forth in claim 15.

Regarding claim 24, Wagner teaches an information managing method in an apparatus (8) for transmitting and receiving information to and from at least an information server (16) and a plurality of terminal devices (10, 12, 14), said method comprising the steps of a reading process of reading the information in the information server (col. 6 lines 24-26), a storing process of storing the information read in the reading process (col. 6 lines 26-29), a notify process for notifying a status of the information stored in the storing process to indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and a transmission process for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes. Furthermore, neither Wagner nor Wang specifically teaches transmitting the information in response to an access made by the terminal device. However, Fuller

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teaches a method to retrieve messages in response to access made by recipient's terminal (col. 2 lines 35-68). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Wagner and Wang to transmit the information in response to an access made by the terminal device, as per teaching of Fuller, because it causes a message to be received at a reception side in a confidential manner.

Regarding claim 27, the limitations of the claim are rejected as the same reasons set forth in claim 12.

Regarding claim 28, the limitations of the claim are rejected as the same reasons set forth in claim 13.

Regarding claim 29, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 30, the limitations of the claim are rejected as the same reasons set forth in claim 15.

Regarding claim 31, the limitations of the claim are rejected as the same reasons set forth in claim 9.

Regarding claim 34, the limitations of the claim are rejected as the same reasons set forth in claim 12.

Regarding claim 35, the limitations of the claim are rejected as the same reasons set forth in claim 13.

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Regarding claim 36, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 37, the limitations of the claim are rejected as the same reasons set forth in claim 15.

Regarding claim 38, the limitations of the claim are rejected as the same reasons set forth in claim 16.

***Response to Arguments***

6. Applicant's arguments filed 10/9/2001 (paper no. 10) have been fully considered but they are not persuasive.

Applicant's response has been thoroughly reviewed and considered and it is noted that the response does not specifically address to claims or rejections. Accordingly, applicant's arguments against the references individually and assert the results from the combination of the applied arts based on their objectives, such as "Wagner discloses a system and method for notifying user about information or events of a medical enterprises..." (page 12 in the response) and "The apparatus which would result from the combination of the Wagner apparatus and the Wang apparatus is a medical enterprise system including a telephone answering machine...receiving the e-mail" (page 13 in the response). It appears that such assertions have no citation of how the Office Action was specifically lacking the claimed limitations or why the Office Action was improper. In addition, the above Office action clearly indicates how the prior arts read on the claimed limitations. Although

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Wagner is objected to a medical enterprise system, Wagner also teaches the medical enterprise system for communicating e-mail message (col. 5 lines 61-66), wherein the medical enterprise system comprising access means (22), a memory (24), event monitor (4), and transmission means, and the use of Wang is to teach of modifying the apparatus of Wagner as a telephone (see rejection above). Specifically, the 103 rejections of above clearly indicate: (1) what the primary reference shows; (2) what the primary reference does not show; (3) what the secondary reference(s) shows; (4) how the references can be combined; and (5) why they can be combined. Since these points were made in the 103 rejections, the 103 rejection is proper. In conclusion, all of applicant's arguments are broad, non-specific arguments and contain no specifics and no specific mentions of the actual rejections or make any specific reference to the claims or specification to overcome the rejections.

Furthermore, Applicant's argument stated that "the examiner's assertion that the Murakami apparatus has memory status means for storing each status of the electronic mail stored in the mail memory so as to correspond to each of a plurality of terminal devices". However, it appears that the use of Murakami is for teaching an electronic mail system for providing a key for deleting respective electronic mail message (see paragraph 4 of present Office action). Thus, applicant's argument in regards to the examiner assertion is incorrect.

In addition, applicant stated that each of foregoing independent claims recites "wherein the electronic mail managing function is provided logically between the mail server and the plurality of terminal devices, and wherein the electronic mail managing function integrately manages the

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electronic mail based on the status of the electronic mail corresponding to each of the terminal devices". However, such limitations are taught by Wagner (col. 5 lines 15-25 and figure 1).

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tyroler (US PAT. 6,320,941) discloses a device dedicated to provide information to a customer regarding e-mail messages (abstract). Quinn (US PAT. 5,944,786) discloses an automatic e-mail notification system without requiring log-on to e-mail server (abstract).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any response to this final action should be mailed to:**

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-6306, (for formal communications intended for entry)

**Or:**

(703) 308-6296 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

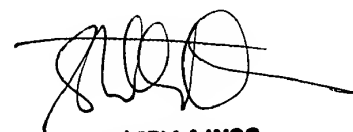
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

GEORGE ENG

December 28, 2001



**STELLA WOO**  
PRIMARY EXAMINER